

REMARKS

Status of the claims

Claim 1, as amended, and claims 2-9 as originally filed are pending in this application. Claim 10 has been cancelled without prejudice.

Claims rejections under 35 USC § 112, first paragraph

The Patent Office rejects Claims 1 – 7 and 10 under 35 USC § 112, first paragraph, for failing the enablement requirement for prognosis of disease in cancer patient other than breast or prostate cancer.

Without acquiescing to the grounds of this rejection, and in an effort to expedite prosecution of this application to allowance, Applicants have amended the claim 1 to recite that the method is directed to breast and prostate cancer patients. As acknowledge in the Action, the currently-presented claims are fully enabled by specification of the application. Applicants thus respectfully request the Patent Office to reconsider and withdraw the rejection.

The instant Office Action further asserts that the claims broadly encompass any method to measure the extent of microvascularization and thus are not enabled.

However, MPEP Section 2164.01, Paragraph 1 states that “[a]ny analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.” Furthermore, according to Paragraph 2 of MPEP Section 2164.01, “[t]he fact that the experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.”

Applicants respectfully submit that it is within the skill of one having ordinary skill in the art to select the most appropriate method for determining microvascularization for a particular tumor sample, and that the Action has not established that one having ordinary skill in the art would not be able to practice the claimed invention without the exercise of undue experimentation. Thus, Applicants respectfully submit that the unrebutted evidence of record shows that the currently-amended claims are fully enabled by the specification as filed, and thus respectfully request the Patent Office to reconsider and withdraw the rejection under 35 USC § 112, first paragraph.

Claims rejections under Obviousness Type Double Patenting

The Office Action further rejected Claims 1-9 on the ground of non-statutory obviousness-type double patenting over Claims 1-7, 9 and 10 US Patent No. 6,303,324. The applicants respectfully traverse the rejection.

“Obviousness like double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent.” MPEP, Section 804, II, B, 1. The instant application is a divisional application claiming priority to U.S. Serial No. 09/199217 filed on November 24, 1998 (now US Patent No. 6,303,324). The Patent Office has thus previously determined that the invention claimed in the instant application is patentably distinct from the invention claimed in U.S. Patent No. 6,303,324. As the subject matter of currently submitted application is patentably distinct from the subject matter of the referenced US patent, Applicants request the Patent Office to reconsider and withdraw the rejection under obviousness-type double patenting grounds.

Conclusion

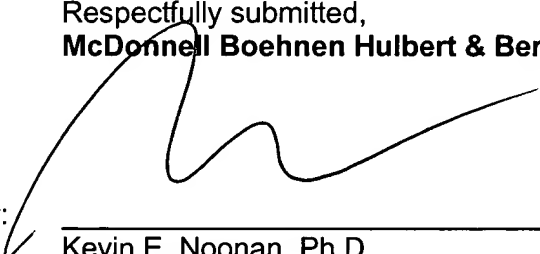
Applicants respectfully contend that the instant application is in condition for allowance in view of the claim amendments and arguments presented above, and respectfully requests it be allowed.

If the Examiner believes that a telephone or personal interview would expedite prosecution of the instant application, the Examiner is respectfully invited to call the undersigned attorney at (312) 913-0001.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff

Dated:

By:



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